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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/502,212  
Filing Date: July 20, 2004  
Appellant(s): CHAMP ET AL.

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James J. Napoli  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 6-4-2008 appealing from the Office action mailed 10-18-07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

WO99/44648	HAHNLE ET AL.	9-1999
6,455,600	HAHNLE ET AL.	9-2002

WO 00/63295	HAHNLE ET AL.	10-2000
CA-2,370,380	RIEGEL ET AL.	10-2000

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 and 12-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' recitation that their defined basic polymer is free of acid monomers was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Note also that the express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded which clearly demonstrates that the introduction of negative limitations not explicitly provided for by the specification

as originally filed do, in fact, introduce new concepts and are therefore new matter. Ex parte Grasselli 231 USPQ 394.

The only section of applicants' supporting disclosure which may be viewed to approach support for the element now recited in applicants' claims is set forth at page 5 lines 29-30 of applicants' supporting disclosure. However, it is not seen how the limitation "said basic polymer free of acid monomer" can be extrapolated from the supporting disclosure's recitation, in setting forth additional copolymers of their disclosure, that "the comonomers are preferably free of acid groups". The equivalence between the original disclosure and the limitation now recited in the claims is not seen.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/44648 {equivalent to USPAT 6,455,600} in view of WO00/63295{equivalent to CA-2,370,380}.

WO-'648 discloses preparations of superabsorbent foamed article prepared from polymers derived from ethylenically unsaturated monomers, crosslinker, surfactant, and entrained inert gas (see the abstract, as well as, entire document, including equivalent

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document US-'600). WO-'648 differs from applicants' claims in that the basic polymers of applicants' claims are not particularly required. However, WO-'295 discloses employment of basic polymers of applicants' claims in combination with acidic polymers in amounts meeting those of applicants' claims in the formation of good hygiene articles having superabsorbent effects (see the abstract, as well as, the entire document, including equivalent document CA-'380). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the polymer systems of WO-'295 in the preparations of WO-'648 for the purpose of providing acceptable and hygienic effects in products realized in order to arrive at the products of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

#### **(10) Response to Argument**

Appellants' arguments have been considered. However, rejections are maintained.

As to appellants' arguments regarding the rejection under 35 USC 112 1st paragraph, it is held that appellants' arguments do not refute the holdings set forth in the rejection above. Though appellants may disclose basic polymers that are free of acid monomers, the disclosure does not provide support for the elements that are now implied to be permissibly included. Appellants' other indicated holdings of law have been considered. However, they do not negate the new matter situation here which is supported as proper by the holdings of *Ex parte Grasselli* 231 USPQ 394.

Additionally, as indicated in the rejection above, the supporting disclosure refers to comonomers which may be used in conjunction with the basic polymers of the instant invention. Although these additional comonomers are indicated to be preferably free of acid groups, it is not seen that such a statement is supportive of appellants' recitation in the claims that the basic polymer is free of acid monomers. It is maintained to be properly held that it is not seen how the limitation "said basic polymer free of acid monomer" can be extrapolated from the supporting disclosure's recitation, in setting forth additional copolymers of their disclosure, that "the comonomers are preferably free of acid groups". Appellants have not demonstrated how such an extrapolation from the supporting disclosure can be made, and the equivalence between the original disclosure and the limitation now recited in the claims is not seen.

As to appellants' arguments regarding the rejection under 35 USC 103, it is held and maintained that rejection is proper.

Examiner maintains the substitution of the polymer system of WO-'295 for the polymer system used in the preparations of WO-'648 is an operation within the skill of the ordinary practitioner in the art. It has been held that it is prima facie obvious to substitute equivalents, motivated by the reasonable expectation that the respective species will behave in a comparable manner or give comparable results in comparable circumstances. *In re Ruff* 118 USPQ 343; *In re Jazel* 158 USPQ 99; the express suggestion to substitute one equivalent for another need not be present to render the substitution obvious. *In re Font*, 213 USPQ 532.

WO-'295 is directed towards expanded/foamed hydrogels which are used in absorbent devices such as diapers {see abstract and column 1 lines 5-15 of equivalent US-'600}. The secondary teaching is also directed towards hydrogel materials that are used in absorbent hygiene articles such as diapers {see abstract and page 1 of equivalent CA-'380}.

These teachings constitute analogous art. The determination if a reference is from a non-analogous art is twofold. First, it is decided if the reference is within the field of inventor's endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058. {see also *In re Bigio*, 381 F.3d 1320, 72 USPQ2d 1209 (Fed. Cir. 2004) and M.P.E.P. 2141.01(a)}. The secondary WO-'295 teaching is maintained to be analogous art. It is held to meet the first requirement in that being drawn to superabsorbent hydrogel materials used in hygienic devices. Even if it is not within the precise field of inventor's endeavor, the second criteria of being reasonably pertinent to the particular problem with which inventor was involved is met in that WO-'295 is directed towards the preparation of closely related articles and absorbent articles based on polymer systems of the instant concern.

WO-'295 is not looked to for the foaming operations disclosed by appellants' claims, because such foaming operations are already provided for by the primary, WO-'648, teaching. What the secondary teaching does provide is that acceptable hygienic devices may be prepared based on blends of basic polymers and acidic polymers, and it is held and maintained that use of the blends of basic and acid



polymers provided for by WO-'295 in substitution for the acid polymers formed in the preparations of WO-'648 is an equivalent substitution that would have been within the purview of the ordinary practitioner in the art in light of the combined teachings of the cited prior art. It is noted, too, that appellants' own diagramming of the formation scenario for their invention (see page 29 of the Appeal Brief) acknowledges that acid polymers may be present in combination with the basic polymers of their claimed invention.

WO-'295 is being looked to for its teaching that basic polymer systems are acceptably used in conjunction with acidic polymers in making absorbent hygienic articles. That WO-'295 may be exemplifying blends of formed acidic and basic polymers does not negate what its full teaching provides. The WO-'295 reference provides for forming and crosslinking the polymers of their concern to form superabsorbent particles {see p.10 line 47-p.15 line 9 of equivalent CA-'380}. Accordingly, it is maintained that based on the combined teachings of the cited prior art substitution of these equivalent polymer forming systems into the absorbent article forming systems of the WO-'648 teaching would have been within the purview of the ordinary practitioner in the art.

Further evidence as to the arrival at the preparations of the instant claims from the combined teachings of the cited prior art resides in the fact that WO-'648{see p.24 line 28- page 25 line 12 of equivalent CA-'380} allows for formation of blends of absorbent polymer with polymer forming systems such that it is seen that control of the blending parameters of polymer and polymer forming materials to be used in

substitution for the polymer forming materials used in the making of the preparations of WO-'648 would have been within the purview of the ordinary practitioner in the art.

Also, WO-'648's disclosure {see p. 25 lines 30-31 of equivalent CA-'380} equivalently identifies the acid polymers I and basic polymers II to be hydrogel forming polymers which offers further testament to their functional equivalence as materials used interchangeably in the manufacture of water absorbing crosslinkable hygienic articles.

It is further noted, that systems of the instant concern, including appellants' claims and WO-'648, allow for the neutralization of the ionic groups of their particular concern. These groups are generally neutralized to form salt groups which allow for better absorption of water. Once these groups are neutralized to their salt, whether they acidic or basic groups, they become functionally equivalent salt groups, and patentable distinction in their selection and use in the making of the articles of the instant concern is further negated.

As to appellants' arguments regarding the foaming operations of the instant concern, it is held that appellants' means of dissolving gas is not differentiated from the teachings of the primary WO-'648 reference in the patentable sense. As the monomer mixture of WO-'648, which contains the fine bubbles, begins to polymerize, it meets the requirements of appellants' claims that a crosslinkable polymer be foamed by dissolving gas within its composition. Additionally, WO-'648 {see equivalent US-'600 column 12 lines 30-32} provides that the foams may be produced under pressures encompassed by appellants' claims. Further, it should be noted that the above address of gas

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entrainment timing is only required for the process claims of the instant concern since difference based on the timing of gas entrainment is not seen for the final articles realized in the product made by the processes of the instant concern.

Appellants' arguments as to differences in the crosslinking of their claims versus the cited prior art are noted. However, difference in the claims is not made evident by limitation to reflect such differences. It is seen that as polymerization of the monomers commence in the preparations of the WO-'648 teaching, the manner of crosslinking to the degrees required by appellants' claims would be met by the teaching of WO-'648. Difference based on crosslinkers/crosslinking to the degree and in the manner defined by appellants' claims is maintained to be not evident. Further, it is maintained that upon inclusion of the basic polymer forming systems provided from the teachings of WO-'295 in the preparations of WO-'648 that crosslinking through the pendant groups of the basic polymer would be a resultant effect as polymerization commences to the degrees required by appellants' claims.

Further, regarding appellants' arguments as to the exclusion of acid groups from the basic polymer, appellants' claims do not exclude the additional acid polymers of the prior art, but, rather, merely require that the basic polymer be free of acid monomers. These conditions are met by the combination of the prior art. It is noted, again, that appellants' own diagramming of the formation scenario for their invention (see page 29 of the Appeal Brief) acknowledges that acid polymers may be present in combination with the basic polymers of their claimed invention.

As to appellants' product claims, it is maintained that appellants have not identified differences in their product based on the manner in which their preparations are formed, nor have they identified the differences in the resulting products structure for the product claims based on the manner in which the products are formed.

Further, upon inclusion of the basic polymer provided from the teachings of the secondary reference, the crosslinking through the pendant groups of the basic polymer would be a resultant effect associated with the selection of the basic polymer. Further, this crosslinking discussed in applicants' reply is not reflected by limitations in applicants' claims.

Appellants' additional arguments regarding additional grouping of claims are noted. However, they are seen to be addressed by arguments set forth above, with addition of the following:

Inclusion of preformed water absorbent particles as additives in systems of the instant concern are provided for by the combinations of the prior art {note: component (g) in abstract and column 10 lines 29-46 of WO-'648 equivalent US-'600 and the arguments and citations set forth in the arguments above}, and sizing of these particles in the manner as claimed are provided for {see page 26 lines 1-7 of WO-'295 equivalent CA-'380} such that distinction based on these additional limitations in the patentable sense is not seen.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John M. Cooney, Jr.

/John Cooney/

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